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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,599	09/15/2003	Bruce L. Kennedy	02580-P0085B	2356

24126 7590 10/12/2010
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EXAMINER

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ART UNIT	PAPER NUMBER
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3779

MAIL DATE	DELIVERY MODE
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10/12/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 *Ex parte* BRUCE L. KENNEDY
11

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13 Appeal 2009-006421
14 Application 10/662,599
15 Technology Center 3700
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18 Oral Hearing Held: May 12, 2010
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21 Before JENNIFER D. BAHR, STEFAN STAICOVICI, and
22 FRED A. SILVERBERG, *Administrative Patent Judges*.
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1 The above-entitled matter came on for hearing on Wednesday, May
2 12, 2010, commencing at 1:57 p.m., at the U.S. Patent and Trademark
3 Office, 600 Dulany Street, Alexandria, Virginia, before Victoria L. Wilson,
4 Notary Public.

5 THE USHER: Calendar number 53. Appeal number 2009-6421.

6 Mr. Oberdick.

7 JUDGE BAHR: Good afternoon, Mr. Oberdick.

8 MR. OBERDICK: Good afternoon.

9 JUDGE BAHR: You can get started whenever you are ready.

10 MR. OBERDICK: Okay. I was hoping first to just give you a little bit of
11 background about the invention. I think it really helps a little bit, if that's okay
12 to do that.

13 Obviously, what we are talking about here is a video endoscope and an
14 associated control and display that are tied to the video endoscope.
15 You know, traditionally, how these things had worked were that you had
16 your -- you have your endoscope, it has usually a CCD or some other type of
17 imaging device in it, and that's connected to a controller. And then the
18 controller, which, for decades now, the standard has been to have these
19 controllers arranged in a rack, as opposed to just, you know, scattered about
20 the operating room.

21 That controller, then, is connected to a display, a video monitor, which,
22 sometimes, it may be attached to the top of the rack. More often than not, they
23 hang down from the ceiling of the operating room, so that the rack would plug
24 into it and, you know, basically, as images are being captured using the
25 endoscope by the surgeon, they are shown on the display.

1 The surgeon uses, traditionally, many buttons, you know, on the controller
2 that's in the rack. Usually they would have a couple of LED displays, they
3 would have a bunch of buttons on them, some gauges, dials, various things to
4 control different aspects of the endoscope.

5 Now, as technology has developed, you know, one of the things that happened
6 was that all of those buttons and LED displays and dials were replaced by soft
7 keys, essentially little touch screens, which made things a lot easier. It is a lot
8 cheaper than having all these mechanical buttons. It also makes it easier for
9 the surgeon to find the appropriate controller because the buttons on the soft
10 keys will change depending upon how the endoscope is currently being used.
11 Things that would be irrelevant at the time are just not shown. You know, so,
12 basically, that, you know, little touchscreen on the controller would -- would
13 update with soft keys.

14 Now, one of the disadvantages of that type of system is that, again, typically
15 the display would be separate. The display may be mounted to the ceiling.
16 The controller is in the rack. So that the surgeon -- you know, say the surgeon
17 wanted to adjust the illumination. The surgeon would be adjusting the
18 illumination using the soft keys on the controller while at the same time
19 looking up at the ceiling to adjust the illumination to try to get it just right and
20 it is a little bit difficult, especially when you are dealing with soft keys, you
21 have no tactile feedback for your fingers, so you are constantly looking down
22 at the soft keys to make sure you are hitting the proper area while looking up at
23 the screen until you get just the right illumination.

24 That became even more disadvantageous, that system, where now it is being --
25 it is typical for entire surgeries to be documented, you know, on video, so that,
26 for example, if the surgeon -- there is a particular feature during a surgery that

1 the surgeon wants to make sure that he or she captured, you know, you may
2 actually stop the surgery, use those -- the soft keys to pause, rewind.
3 Now, again, you are looking up at the screen, at the display, while you are
4 using the little soft keys on the controller to try to adjust the video back and
5 forth in time to make sure that you capture what you wanted to capture. It was
6 very difficult. It would have been much more advantageous if you could put
7 the video right on the controller, you know, so that you could be looking at the
8 controller while you are adjusting the soft keys on the controller.

9 The problem with that was that these -- the displays on the controllers
10 traditionally have been very small, low resolution. You could not have a nice
11 big bright display on the controller because it would simply be too big. You
12 would end up taking up three spots in the rack and the rack space is very -- you
13 know, it is limited.

14 So, basically, that's -- that's the problem that the inventors were facing here
15 was that, you know, they were trying to remedy those problems. What they
16 came up with is this -- you know, this controller that takes up on a rack but
17 that does allow you, if you do a particular -- you know, particularly, when you
18 get into these -- these video -- you know, video capture and, you know, these
19 surgeries where you are capturing the video and you want to control it, you can
20 pull out the -- pull out the display out of the face, maybe tilt it down, now you
21 have your nice big display, all your controls are right there.

22 You do still have the other display probably on the ceiling for everybody else
23 in the operating room to see but it really aids in whoever is controlling the
24 controller to be able to see the video right there on the controller where the soft
25 keys are.

26 So, that -- you know, I don't know if you have any questions about, you

1 know, just the background before we get into --

2 JUDGE BAHR: No.

3 MR. OBERDICK: So, now, getting into the claims and the prior art,
4 obviously, there is the one independent claim 19, you know, which is, you
5 know, specifically directed -- you know, we don't -- we don't talk, I recognize,
6 about the rack-mounted nature of the controller but there are features here that
7 are basically dictated by that.

8 The -- really where I think the novelty is -- you get into the touchscreen also
9 having the video display on it, which is obviously an important aspect, but
10 then you get into the housing, which is enclosing the processor, and you get
11 into the touchscreen being movable between these positions where you are --
12 one position is within the footprint of the housing, which would be the
13 retracted position, and then the extended position, where it -- the screen is now
14 pulled out of the housing.

15 Now, looking at the main cited prior art reference, Beutter, what does that
16 really disclose? You know, I would say it really doesn't disclose much with
17 respect to everything that we just talked about.

18 You know, if you look at the whole -- the whole reference, it is obviously very
19 concerned with the endoscope itself. You look at the figure, you know, there
20 is all the gears and the focusing and, you know, everything that we talked
21 about, to the extent that it is disclosed, is very incidental and briefly
22 mentioned. Obviously, there is a display monitor to display the video, 36.
23 You know, you have your controller, the operating room control center, 42,
24 shown in the figures. The monitor is 36. Really what the entire crux of this
25 reference comes down to is an incidental mention that the -- in response to

1 touchscreen or voice generated commands, the operating room control center
2 generates control signals.

3 Basically, the Examiner takes that statement and assumes that the touchscreen
4 must be the monitor, 36, the video monitor, which I think -- that's a big
5 assumption right there. There is no disclosure of that. It is certainly not how
6 the current state of the art is configured.

7 But the Examiner has to make that assumption in order to satisfy the claim
8 limitation that the touchscreen is also displaying the video.

9 Now, the main -- one of the secondary references, Winkler, is directed to this
10 portable and programmable -- basically, it is a defibrillator that has a flip-up
11 touchscreen that flips up off the top.

12 You know, it is Applicant's contention, first of all, that when you have these
13 two systems, when you have -- basically, what Applicant would contend is just
14 the state of the art because, you know, Beutter really doesn't teach anything
15 beyond that and beyond the display screen and the control head.

16 Applicant would say that it is likely, at least just as likely, that the -- that the
17 touchscreen is a small soft key type touchscreen that's mounted on the
18 controller, as opposed to the Examiner's assumption that it is -- that the
19 touchscreen is the same as the video monitor.

20 But, regardless, if you have that, basically, system, which essentially
21 represents the current state of the art, and you put it next to this portable
22 defibrillator with a flip-up display, really what would be the motivation to
23 arrive at the claimed limitation with those two devices in front of you.

24 The Examiner, you know, says that it would be to, basically, protect the
25 screen, I believe. But, again, it just -- it really wouldn't -- given the state of the
26 art, that combination really just wouldn't work, first of all. When you have --

1 again, you have these rack-mounted displays which Beutter doesn't teach and
2 is not what we are talking about here and, you know, you have a flip-up
3 display screen that's disclosed and is perfectly acceptable in these portable
4 defibrillator case.

5 It just wouldn't work to combine the flip-up screen with the control center that,
6 again, is typically rack-mounted. There is just no room in the rack for it. It
7 just wouldn't work.

8 That's why Applicant came up with this -- essentially, this pull-out screen,
9 which brings me to the second -- the second point is that even if you did make
10 that combination, Applicant would submit that the claim still would not be
11 satisfied.

12 Again, the claim requires that two positions -- at least two positions for the
13 screen. You have the one position where the screen is wholly within the
14 footprint, which, obviously, Winkler would disclose, but then you also have
15 the second position, the extended position, where the screen is extended from
16 the footprint of the housing, and I believe that Winkler just doesn't disclose
17 that. Winkler discloses a flip-up screen but there is no disclosure even when
18 flipped up that it is -- that the screen would be outside of the footprint of the
19 housing as Applicant --

20 JUDGE STAICOVICI: How would you define "footprint"?

21 MR. OBERDICK: I think, basically, "footprint" would have a definition that
22 anyone skilled in the art would know and, essentially, that would be,
23 essentially, the cross-section that would be taken up by the device by the
24 control head. In our particular case, it is very important because we are
25 talking about rack-mounted here --

26 JUDGE STAICOVICI: Rack mounting does not appear in claim 19.

1 MR. OBERDICK: No, but it informs why the footprint is important.

2 JUDGE STAICOVICI: For example, in figure 6 of Winkler, what would you
3 say is the footprint there?

4 MR. OBERDICK: I would say it would be, you know, essentially looking
5 down from the top, it would be the cross-section, the area taken up by the
6 periphery. I think that would be the generally accepted definition of
7 "footprint" would be that when you place the thing -- when you place whatever
8 we are talking about in its, you know, typical operating state, its typical
9 configure --

10 JUDGE STAICOVICI: If that's a plane, when you pull the screen upwards, it
11 is outside that plane.

12 MR. OBERDICK: I'm sorry?

13 JUDGE STAICOVICI: If the footprint is the plane in which the screen lies,
14 once you pull the screen upwards, it is going to be outside that plane.

15 MR. OBERDICK: I think -- I think the footprint, basically, again, is looking
16 at something from the top, the outer boundaries of the periphery, which if you
17 were looking at this in figure 6 of Winkler from the top, you can envision what
18 the outer boundary of the periphery would be and that periphery would not be
19 broken -- that footprint would not be broken when you flip the screen up.

20 And, again, although I definitely recognize that the rack-mounted nature is not
21 claimed in claim 19, that is the -- this footprint concept is critical because of
22 the rack-mounted nature. Basically, we are requiring that the extended
23 position be a pull-out to break, essentially, the planes that would be defined by
24 the outer periphery when you are looking at this thing from above. And,
25 again, I think that's what the definition of "footprint" is as would be recognized
26 by one skilled in the art would be.

1 And even a long those same lines, now when we get to one of the dependent
2 claims, which I think is probably the most important dependent claim, 49,
3 where we even more narrowly define what we are talking about here, we go
4 beyond footprint and we basically require that, in the first position, the
5 touchscreen is positioned within an interior cavity of the housing, and then
6 when it is moved to the second position, the screen is at least partially outside
7 of that cavity.

8 Again, Winkler itself expressly, column 12, beginning on line 11, recognizes
9 that there is a housing, 202, and that the display unit is disposed on the upper
10 surface of the housing. You know, there is -- I just don't see how any
11 argument could be made that the display is within an interior cavity of the
12 housing.

13 JUDGE STAICOVICI: However, Winkler is not used for claim 49, at least
14 that's what we have here. Claim 49 is Beutter and Rosen.

15 MR. OBERDICK: Rosen, right, which I believe is even less relevant and,
16 really, I would say completely irrelevant. You know, there -- there is really --
17 you know, basically, what we are talking about here, I don't even think there is
18 a touchscreen here. There is a video display. I -- unless I missed it, I just -- I
19 really don't see any disclosure suggestion of any sort of touchscreen.

20 Really what we are talking about here is a video display. It is a little TV that's
21 essentially mounted under a cabinet or on a table, particularly for use in RVs
22 and that sort of thing. Again, it is just a -- it is a space-saving little way to
23 mount a TV on a table or under a counter. I would say that there is no
24 housing -- there is clearly no housing that houses any sort of processor or
25 anything like that. Again, basically, this is just a flip-up TV screen that's

1 mounted under a counter, which I think is completely irrelevant and doesn't
2 get -- it doesn't even disclose the housing as is required by claims 19 or 49.

3 JUDGE BAHR: I was just quickly going through the Brief and I couldn't find
4 the argument that Winkler's touchscreen is not -- doesn't have a second
5 position extended from the footprint of the housing. I didn't see that. I was
6 wondering if you could pinpoint that for me.

7 MR. OBERDICK: I am not -- I agree. I'm not locating any mention of it.

8 JUDGE BAHR: Okay. Well, we will look for it. Thank you.

9 MR. OBERDICK: Now, as far as the -- some of the other dependent claims, I
10 know we argued some of them separately in the Brief. Without getting into
11 each and every one, basically, I think I would just urge you to -- for the ones
12 that we specifically call out, you know, for example, the unpluggable -- I think
13 the examiner is just really assuming -- making a lot of assumptions with
14 respect to a lot of the dependent claims without any support for the
15 unpluggable -- you know, the unpluggable dependent claim, for example,
16 which is claim 20, it seems as though the Examiner is just saying that
17 because -- and claim 20 does require that the touchscreen be unpluggable from
18 the housing.

19 Basically, it seems that the Examiner is saying that they are operatively
20 connected, they must somehow be unpluggable. Again, that's -- I think that's
21 an assumption with no support in any of the references. Just because
22 something is operatively connected, if it requires a set of shears to cut the
23 connection, is that unpluggable? If it requires a soldering iron in order to --
24 you know, basically, meld some connections, is that unpluggable?

1 And there is similar rationale with respect to some of these other dependent
2 claims which are just set forth in the Brief and I don't know that we need to go
3 over them unless you have specific questions.

4 JUDGE SILVERBERG: Do you define "unpluggable" in the specification?

5 MR. OBERDICK: I -- you know, I don't think so. I can't say for sure that we
6 don't but I doubt that we do.

7 Again, I would just say that, you know, unpluggable is something that one
8 skilled in the art would readily understand -- that you can plug something in,
9 you can unplug it, it has plugs on it, essentially, which, again, would be
10 something that I think one skilled in the art would readily understand and
11 would readily understand that to unplug something would -- would not require
12 wire cutters or a soldering iron or something to that effect.

13 JUDGE BAHR: Any further questions? No? Okay.

14 MR. OBERDICK: Okay. Thanks.

15 JUDGE STAICOVICI: One last question.

16 JUDGE BAHR: Sure.

17 JUDGE STAICOVICI: With respect to claim 21 --

18 MR. OBERDICK: Okay. The stackable mating plug portions?

19 JUDGE STAICOVICI: Yes. Can you give an example of what's a stackable
20 mating plug portion?

21 MR. OBERDICK: To be honest, I wasn't prepared off the top of my head to
22 do that. I can -- if you would like, I can try to go through the spec and find
23 that but --

24 JUDGE BAHR: Does that mean they are stackable with one another or
25 stackable with something else or --

1 MR. OBERDICK: It does. It means that the device is -- the controller is
2 stackable with other -- other devices and interconnectable with the other
3 devices that it is being stacked adjacent to.

4 JUDGE STAICOVICI: Thank you.

5 Whereupon, the proceedings at 2:19 p.m. were concluded.

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